

REMARKS

The issues outstanding in the office action of March 2, 2010, are the requirement for restriction and the rejections under 35 U.S.C. 112, 102 and 103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

Requirement for Restriction

Applicants' traversal of the restriction requirement is maintained. It is respectfully submitted that claims 6-9, drawn to a transparent conductive film and process for its preparation, employing the target of claim 1, can be examined without additional burden, irrespective of "special technical feature." Special technical feature, itself, is irrelevant in determination of burden, but reflects unity of invention. However, under U.S. rules, it is clear that where no burden is incumbent to examine additional claims, policy mandates keeping them together in a single application. See MPEP §803.

Rejection Under 35 U.S.C. 112

Claim 4 has been rejected under 35 U.S.C. 112, second paragraph, as a result of a typographical error omitting the unit density. The claim has been corrected, as supported in paragraph 30 of the specification, and withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C. 102

Claims 1-4 have been rejected under 35 U.S.C. 102(b) over Fukuyoshi (JP '841). Reconsideration of this rejection is respectfully requested.

At page 4 of the office action, it is admitted that Fukuyoshi does not disclose or suggest cerium oxide to be positive trivalent. Incorporation of the features of claim 5 in claim 1 thus renders this rejection moot, and withdrawal thereof is respectfully requested.

Rejection Under 35 U.S.C. 103

Claim 5, formerly reciting the positive trivalent state of cerium, has been rejected under

35 U.S.C. 103 over Fukuyoshi taken with Hosokawa (WO '137). Reconsideration of this rejection is also respectfully requested. Both Fukuyoshi and Hosokawa are silent on the abundance of trivalent cerium, that is, the total of cerium +3 and +4. Claim 1 has been clarified to include the abundance ratio, as disclosed at paragraph 62 of the specification. To the extent that Hosokawa arguably "recognized the equivalency" of various cerium oxides, as argued at page 5 of the office action, Hosokawa does not, however, suggest any particular ratio of the trivalent to quadravalent ions. Merely disclosing CeO_2 and CeO_x in a larger list that concludes with "and mixtures" does not suggest to one of ordinary skill the particularly claimed ratio of just these two oxides, in admixture. As a result, it is submitted that the combination of references fails to suggest the present claims, and withdrawal of the rejection under 35 U.S.C. 103 is respectfully requested.

Patentability is further urged for revised claim 3, which recites a ratio of cerium to indium + cerium of 0.005 to 0.035. It is argued, at pages 3 and 4 of the office action, that Fukuyoshi enables calculation of a ratio of approximately 0.05. This ratio is not included in claim 3.

Accordingly, the claims are submitted to be in condition for allowance, and passage to issue is respectfully requested. However, should the Examiner have any questions or comments, he is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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